IFW 1772

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/086,532 Confirmation No. 3809

Applicant : Kauschke, et al.

Filed : February 28, 2002

TC/A.U. : 1772

Examiner : William P. Watkins, III

Docket No. : 34303/48

Customer No. : 1912

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope, with sufficient postage, addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date which appears below:	
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Date:	7-20-04

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests reconsideration of the Advisory Action.

Applicant will limit the arguments herein to those arising from the comments of the Examiner in the Advisory Action.

1. The Advisory Action states:

> Applicant argues a result of increased flexibility at less than 10% basis weight. A flexible barrier layer is the expected result of the practice of the invention of Ciammaichella et al. (see col. 2, lines 60-col. 3, line 10).

Ciammaichella repeatedly mentions in the Background of the Invention section the desirability of flexibility (Col. 2, lines 18-21; lines 35-44; lines 45-49). In the passage cited by the Examiner (Col. 2, lines 60 - Col. 3, line 10), the reference notes that the absorbent article must balance off the "reduction of the protection level" and the "desirable comfort product modifications such as ... improving the flexibility of the

product which would further acerbate [exacerbate] the problem" and concludes that the further desirable product comfort modifications such as flexibility "may not be incorporated in the absorbent article." Except for these references in the Background of the Invention section, there is nowhere any reference to flexibility of the absorbent article -- not in the Summary, not in the Detailed Description, not in the Examples and not in the Claims.

If flexibility is a goal of Ciammaichella, it is most surprising that he mentions it only in connection with the prior art and not in connection with the products of his invention.

2. The Advisory Action states:

> Applicant argues that the examples of Ciammaichella et al. disclose the values of blocking agent greater than the claimed 10% of the total basis weight. The reference is not limited only to the examples, if the lower end of the taught range of 5 gsm was used with the outer sheets and adhesive of Example 1, a value of less than 10% basis weight would be obtained.

However the fact is that the reference teaches only an absolute range for the blocking agent, based on the total weight of the absorbent article, of 5-300 gsm (or preferably 10-250 gsm).

Ciammaichella suggests neither that a selection of the blocking agent quantity within the prescribed range should be based on the basis weight of the total barrier sheet, nor that such a selection be made with the goal of providing flexibility to the barrier sheet.

Ciammaichella posits an absolute quantity of blocking agent in Example 1 such that Applicant's ratio (blocking agent as percentage of total weight) is not met. The Examiner does not contest this. Accordingly, the Examiner suggests using "the lower end of the taught range," so that Applicant's ratio is met. However if one considers instead the higher end of the taught range, a value of more than 10% basis weight would be obtained. Indeed, while using the lower end of the taught range results in a 5.2% basis weight based on the total barrier layer (5/95), using instead the higher end of the taught range results in a 77% basis weight (300/390). Considering the extent of this range (5.2 to 77%), Applicant respectfully submits that Ciammaichella simply does not teach any basis weight for the blocking agent as a percentage of the basis weight of the sheet prior to exposure to liquid. If Ciammaichella teaches anything in this regard, it must be gleaned from the examples he expressly teaches and not by hypothetically extending or expanding the amount of the blocking agent within a specific example to the far extents of the absolute limits which he teaches overall for the blocking agent range. *See Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1326 (Fed. Cir. 2000) ("although the examples provide the data from which one can piece together the...limitation, neither the text accompanying the examples, nor the data, nor anything else in the specification in any way emphasizes the [limitation]"). There is simply no support in the reference for such tampering with the teachings of the examples of the reference.

In *Purdue*, the subject limitation was a ratio of drug concentrations. The Federal Circuit held that the ratio was not taught by the specification, because "there [was]

nothing in the written description of [the] Examples...that would suggest to one skilled in the art that the...ratio [was] an important defining quality of the formulation, nor [did] the disclosure even motivate one to calculate the ratio." *Id.* at 1327. Further, where the disclosure did not indicate that the ratio was part of the invention, it was "immaterial what range for the ratio [could] be gleaned from the examples when read in light of the claims." *Id.* at 1328.

Applicant respectfully submits that Ciammaichella does not teach a basis weight for the blocking agent as a percentage of the basis weight of the sheet prior to exposure to liquid, and therefore, under *Purdue,* such a limitation can not be considered part of the teaching of this prior art reference.[1] *See id.* In fact, nowhere in his entire patent does Ciammaichella make reference to a weight *percentage* of the blocking agent. To infer this value where Ciammaichella has not made any indication that he considers it part of his invention, nor provided any motivation to calculate such a value, is inappropriate. *See id.* at 1326.

The Manual of Patent Examining Procedure ("MPEP") cites *Purdue* with approval for the proposition that "[w]ith respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by...the original disclosure." *MPEP* § 2163.05(III) (8th Ed. 2001).[2]

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[1] This is equally true whether the context is supporting the claims of a patented invention under 35 U.S.C. § 112, or invalidating the claims of another patent application under 35 U.S.C. §§ 102 and 103.

[2] The language of *Purdue* quoted by the MPEP is: "the specification does not clearly disclose to the skilled artisan that the inventors***considered the [] ratio to be part of their invention***. There is therefore no force to Purdue's argument that the written description requirement was satisfied because the disclosure revealed a broad invention from which the [later-filed] claims carved out a patentable portion." *MPEP* § 2163.05(III) (8th Ed. 2001) (quoting *Purdue*, 230 F.3d at 1328).

In view of the above remarks, reconsideration of the Advisory Action and allowance of all claims is respectfully requested.

If an extension of time is required to enable this document to be timely filed and there is no separate Request for Extension of Time, this document is to be construed as also constituting a Request for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed. Any fee required for such a Request for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17 and not submitted herewith should be charged to the Deposit Account of the undersigned attorneys, Account No. 01-1785; any refund should be credited to the same account. One copy of this document is enclosed.

Respectfully submitted

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